

Application No. 10/677,694
Docket No. IB-8 (A4-1770)
Amendment dated November 13, 2006
Reply to Office Action of August 14, 2006

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REMARKS

In the present Office Action, the Examiner withdrew the indicated allowability of claims 15, 16, 32, and 59-63. Ostensibly as a result, the Examiner also withdrew the finality of the previous Office Action, for which Applicants wish to thank the Examiner.

In the Office Action, claims 2, 15, and 65-67 were objected to, claims 2, 4, 7, 8, 10, 13, 14, 16, 18, 20, 22, 24, 26, 28, 30-32, 35, 36, 39, 40, 49-56, 58-63, 68, 71, and 72 were rejected under 35 USC §112 (first paragraph), claims 1, 3, 5, 6, 9, 11, 12, 17, 19, 21, 23, 25, 27, 29, 37, 38, 41-44, 46-48, 57, 59, 69, and 70 were rejected under 35 USC §103, and claims 31, 33, and 34 were allowed.¹

Also in the Office Action, the Examiner advised that "[n]o art has been applied to claims 2, 4, 7, 8, 10, 13, 14, 18, 20, 22, 24, 26, 28, 30, 31, 35, 36, 39, 40, 49-56, 58, 68, 71, and 72, but the art rejection will be revisited upon resolution of the rejection under 35 USC §112, 1st paragraph." In view of the list of claims identified in the Office Action as being rejected under 35 USC §103, claims 60-63 and 65-67 should also be included in the list of claims that

¹ Though claims 33 and 34 were identified as being allowed, claim 33 (from which claim 34 depends) is a dependent claim of rejected claim 1. Therefore, Applicants believe claim 33 was intended to be identified as reciting allowable subject matter, but not allowed *per se*.

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are not subject to a prior art rejection in the present Office Action. If this is incorrect, and in response to Applicants' present response the Examiner subsequently remedies this error by asserting that the limitations of claims 60-63 and 65-67 are met by any prior art now of record, Applicants hereby respectfully request withdrawal of the present Office Action and that a new corrected action be filed and the period for reply restarted under MPEP §710.06.

In response to the above objections and rejections, Applicants have amended the claims as set forth above. More particularly:

Independent claim 1 has been amended to cancel the limitation previously incorporated from its dependent claim 15.

Independent claim 1 has been amended to incorporate all limitations of its dependent claim 59 (canceled without prejudice to Applicants), and to alternatively incorporate the limitations of dependent claims 60-62 (which depend from claim 59) through a Markush group. In view of the latter, claims 60-62 have been amended to depend directly from claim 1 and to reflect, as necessary, the antecedence now provided by claim 1.

Independent claim 2 has been amended to clarify that the three limitations at the end of the claim are alternative members of a Markush group, and therefore are not being claimed as simultaneously limitations for the

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subject matter of claim 2.

Dependent claims 15, 16, and 32 have been canceled without prejudice to Applicants.

Dependent claim 66 has been amended to reflect the antecedence provided by its parent claim 2.

Applicants respectfully believe that the above amendments do not present new matter, and request favorable reconsideration and allowance of remaining claims 1-14, 17-31, 33-44, 46-58, 60-63, and 65-72 in view of the above amendments and the following comments.

Objections to the Claims

Claim 2 was objected to as lacking proper antecedence for the "pacing-ICD unit." This objection is overcome by amending claim 2 in accordance with the Examiner's suggestion.

Claim 15 was objected to as repeating a limitation inserted in its parent claim 1. This objection is overcome by canceling the limitation from claim 1.

The Examiner objected to claims 65, 66, and 67 as repeating limitations inserted in their parent claim 2. However, the limitations in question are part of a Markush group and are therefore "alternative limitations" of claim 2

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(MPEP 2173.05(h)), whereas claims 65, 66, and 67 individually and positively require that the subject matter of claim 2 includes their respective limitation. Therefore, claims 65, 66, and 67 do not recite limitations that are redundant to their parent claim 2, and Applicants respectfully request withdrawal of the objections to claims 65, 66, and 67.

Claim Rejections under 35 USC §112

Claims 2, 4, 7, 8, 10, 13, 14, 16, 18, 20, 22, 24, 26, 28, 30, 31, 32, 35, 36, 39, 40, 49-56, 58-63, 68, 71, and 72 were rejected under 35 USC §112 (first paragraph) as failing to comply with the written description requirement, and claims 2, 4, 7, 8, 10, 13, 14, 18, 20, 22, 24, 26, 28, 30, 31, 35, 36, 39, 40, 49-56, 58, 68, 71, and 72 were rejected under 35 USC §112 (first paragraph) as failing to comply with the enablement requirement. Reconsideration of these rejections is requested in view of the following comments.

As set forth in the second full paragraph on page 3 of the Office Action and the paragraph bridging pages 4 and 5 of the Office Action, a first part of the rejection based on the written description requirement and the entire rejection based on the enablement requirement were attributable to the Examiner's interpretation that claim 2 simultaneously requires each limitation of the Markush group consisting of the three limitations added to the end of claim

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2 (and incorporated from claims 65, 66, and 67). In response, Applicants note that the Markush group of claim 2 is a list of alternative limitations, and not simultaneous limitations (see MPEP 2173.05(h)). Furthermore, Applicants have amended claim 2 in an attempt to clarify that these limitations are in a Markush group. Therefore, claim 2 does not recite three separate limitations used in combination, and therefore cannot give rise to a rejection based on lack an adequate written description or enablement for their use in combination. Applicants therefore respectfully request withdrawal of these grounds for the rejections under 35 USC §112, first paragraph.

As set forth in the paragraph bridging pages 3 and 4 of the Office Action, a second part of the rejection citing the written description requirement was based on the limitations of claims 16, 32, and 59-63 covering embodiments not disclosed as being used together with the embodiments of their parent claims 1 and 2. In response, Applicants have canceled claims 16 and 32 without prejudice and have addressed the rejection of claims 59-63 by canceling from claim 1 the limitation regarding the drug delivery device. As such, Applicants believe these grounds for the rejection under 35 USC §112, first paragraph, are also overcome.

Finally, though claim 31 was listed as being rejected under both explanations for rejections under 35 USC §112, first paragraph, claim 31 is an

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independent claim that does not recite any of the combinations of limitations that gave rise to the rejections of the other claims. Therefore, Applicants believe that the rejection of claim 31 was in error.

The actions taken above are not to be interpreted as an admission or opinion that the various limitations cannot be used together. Applicants respectfully request withdrawal of the rejections under 35 USC §112, first paragraph.

Rejections under 35 USC §103

As noted above, independent claim 1 and all of its dependent claims except claims 33, 34, and 60-63 were rejected under 35 USC §103, and dependent claims 33 and 34 were specifically identified as reciting allowable subject matter. As noted above, Applicants have amended claim 1 to alternatively incorporate the limitations of its claims 60-62 through a Markush group, such that claim 1 requires one of the alternative limitations from claims 60, 61, or 62. Therefore, Applicants respectfully request withdrawal of the rejections under 35 USC §103 of claim 1 and its remaining dependent claims.

Applicants have taken this action on the basis that claims 60-63 were not identified in the Office Action as being rejected in view of any prior art. If this is incorrect, and in response to Applicants' present response the Examiner

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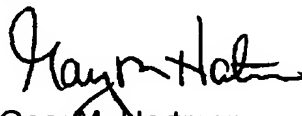
subsequently asserts that the limitations of claims 60-63 are met by any prior art now of record, Applicants hereby respectfully request withdrawal of the present Office Action and that a new corrected action be filed and the period for reply restarted under MPEP §710.06.

Closing

In view of the above, Applicants believe that all issues outstanding from the Office Action have been addressed, and that the claims define patentable novelty over all the references, alone or in combination, of record. It is therefore respectfully requested that this patent application be given favorable reconsideration.

Should the Examiner have any questions with respect to any matter now of record, Applicants' representative may be reached at (219) 462-4999.

Respectfully submitted,

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